

AMENDMENT UNDER 37 C.F.R. § 1.111

U.S. Application No.: 10/725,327

Attorney Docket No.: Q78609

the fine particles have an electrokinetic potential of from about -100 mV to -10 mV in an aqueous environment at pH 5, and wherein the crystal form of the titanium dioxide fine particles is brookite.

In essence, the Examiner states Sanbayashi et al disclose all of the features of the present claims, except that Sanbayashi et al are silent with respect to the electrokinetic potential value of their coating composition. The Examiner argues that the electrokinetic potential value of the Sanbayashi et al coating composition is an inherent value, and would be expected to have the same electrokinetic potential value as the present claims because Sanbayashi et al disclose the same composition as the present claims. The Examiner apparently believes that the coating composition of Sanbayashi et al is the same as the present because Sanbayashi et al disclose the use of phosphorus-containing compounds as a binder.

Applicants disagree with the Examiner's analysis.

Sanbayashi et al disclose, at col. 6 lines 3-16, that an arbitrary component can be incorporated into their composition. Sanbayashi et al state that the arbitrary component can be a surfactant, and that examples of the surfactants include anionic surfactants. In addition, Sanbayashi et al disclose, at col. 5, lines 21-36, that a binder can be employed, and that the binder can be a phosphorous containing compounds, including phosphoric acid, polyphosphoric acid and aluminum phosphate. The present specification discloses at page 6 that various polyphosphoric acids, such as tripolyphosphoric acid and tetrapolyphosphoric acid, can be used as the anionically active substance.

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With respect to the electrokinetic potential, however, Sanbayashi et al do not disclose any information concerning the electrokinetic potential, or the dependency of the electrokinetic potential on the amounts of specific components.

Example 1 and Comparative Examples 4 and 5 of the present application establish that the electrokinetic potential depends on the amount of anionically active substance that is present in the composition. Thus, Examples 1 and Comparative Examples 4 and 5 each contained the same components, but contained the sodium hexametaphosphate (the anionically active substance) in different amounts. Only Example 1, however, had the claimed electrokinetic potential.

Accordingly, applicants submit that it is clear that the electrokinetic potential of a composition depends on the specific components and amounts that are contained in the composition, and that the disclosures of anionic surfactants or phosphorus-containing compounds in Sanbayashi et al do not inherently satisfy the recitations of the present claims.

In view of the above, applicants submit that Sanbayashi et al do not anticipate claim 2 and claims 3 and 6-18 that depend from claim 2. Accordingly, applicants request withdrawal of this rejection.

Claim 5 has been rejected under 35 U.S.C. § 103(a) as obvious over Sanbayashi et al.

The Sanbayashi et al patent is owned by Showa Denko, K.K., which is also the owner of the present application. The Sanbayashi et al patent issued on November 12, 2002, and thus was copending with applicants' parent application 09/839,418 filed on April 23, 2001. The present application, therefore, has an effective filing date of April 23, 2001.

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Applicants submit the following statement to establish common ownership of the present invention and the subject matter disclosed in the Sanbayashi et al patent, at the time the present invention was made, in order to disqualify the Sanbayashi et al patent as prior art under 35 U.S.C. § 103(a).

The subject matter of the above-identified Application No. 10/725,327 and parent application 09/839,418 filed on April 23, 2001 and U.S. Patent No. 6,479,141 to Sanbayashi et al were, at the time the invention of Application No. 10/725,327 was made, owned by Showa Denko, K.K.

In view of the above, applicants submit that U.S. Patent No. 6,479,141 to Sanbayashi et al cannot be used as a reference under 35 U.S.C. § 103(a) against the present claims.

Accordingly, applicants request withdrawal of this rejection.

Claim 19 has been rejected under 35 U.S.C. § 103(a) as obvious over Sanbayashi et al.

In view of the above statement of common ownership, applicants submit that U.S. Patent No. 6,479,141 to Sanbayashi et al cannot be used as a reference under 35 U.S.C. § 103(a) against claim 19.

Accordingly, applicants request withdrawal of this rejection.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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